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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,398	11/28/2001	Jai K. Baek	212/340	3095

7590

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EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,398

Applicant(s)

BAEK, JAI K.

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference number 11 as cited on page 4, line 11 and reference number 25 as cited on at least page 5, line 2 (it appears that reference number 25 throughout the specification should actually be reference number 24.). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: reference number 24 as noted in Figure 2. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: reference number 24 in Figure 2 is not in the specification. Also, reference number 14 was defined as "toe box" on page 1, line 4 and later referred to as "gel pad" on page 5, line 10. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains the phrase "an cover disposed..." in line 7 of the claim which renders the claim vague and indefinite. It is unclear what is meant to be encompassed by this limitation in the claim. Claim 1 also contains the phrase "the outer cover" in line 9 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 8 contains the phrase "the cover of the toe box..." in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7, 9-16 and 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porcher 4,702,022 in view of Dalvy et al. 5,924,218 and Mashita et al. 5,681,649. Porcher discloses all the limitations substantially as claimed including the following: a liner with multiple resilient layers (see Figure 3A especially, showing an inner liner, a resilient layer on top of the inner liner; a second resilient layer on top of the first resilient layer, and at least an outer cover layer, all shown in the heel and forefoot areas.). All the layers of the liner boot are provided to make the boot more comfortable on the user's foot and to protect the user's foot during use. Porcher '022 does not disclose a gel pad located between any of the layers in the toe box area or the heel area. Dalvy et al. '218 teaches that a gel pad 5 can be located between the layers of an inner boot (especially in the heel area as shown in Figure 1) to aid in protecting the user's foot and to help in cushioning the user's foot and fitting the

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boot to the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, in view of Dalvy et al. '218, to place a gel pad in the heel area of the liner of Porcher '022 to aid in protection and comforting the user's foot within the boot. Mashita et al. '649 teaches that a gel pad, made of styrene and butadiene, can be located in many areas of footwear including the toe box area, to aid in cushioning and protecting the user's foot. Therefore, it would have been obvious to place a gel pad in the toe box area, as taught by Mashita et al. '649, between any of the layers of the toe box to aid in cushioning, protecting and comforting the user's foot within the boot. With respect to the different Shore A hardnesses of the toe box and heel counter, it appears that it would have been a mere matter of testing and optimization to find a combination of material that would provide the desired comfort and protection that would meet the desired total hardness of different areas of the boot.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Wagonhurst 6,082,027. The references as applied to claim 1 disclose all the limitations of the claim except for the resilient pad being fixed to the outside cover of the toe box of the boot liner. Wagonhurst '027 teaches that a cushion pad can be located between the inner boot and the boot shell of a boot to aid in protecting the toes of the user as well as to adapt the inner boot to fit within the outer boot. Therefore, it would have been obvious to place a pad for size adjust on the outside cover of the inner boot to allow for the inner boot to be used within any outer boot that was slightly too large for the inner boot. With the pad affixed to the inner boot, the inner boot would be able to be used in many different outer boots and the pad for adjustability would not be accidentally lost or left in another boot.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 9 above in view of the Japanese reference 1-55802 (JP '802). The references as applied to claim 9 above discloses all the limitations of the claim except for the resilient pad being fixed

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to the outside cover of the heel counter of the boot liner. JP '802 shows, in Figures 1 and 5, that a pad 19 located within a boot can be located between the heel counter of the inner boot and the heel counter of the outer boot shell. This pad protects the heel of the user, in the softer inner boot, from hitting up against the harder outer boot. Therefore, it would have been obvious to place a pad, such as that shown in JP '802, on the outside cover of the inner boot in the heel counter area, as shown in JP '802, to aid in cushioning the impact of the inner boot with the outer boot. With the pad affixed to the inner boot, the inner boot would be able to be used in many different outer boots and the pad would not be accidentally lost or left in another boot.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/



Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS
December 27, 2002